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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,585	11/12/2001	Ronald Breslow	0575/57474-A/JPW/ADM	7720

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EXAMINER	
MCKENZIE, THOMAS C	

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 09/24/2003 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/054,585	BRESLOW ET AL.	
	Examiner	Art Unit	
	Thomas McKenzie Ph.D.	1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: *15-18*.

Claim(s) rejected: *14 and 19-32*.

Claim(s) withdrawn from consideration: _____.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☒ Other: *PTO-892 attached*

DR.MCKENZIE

Continuation of 5. does NOT place the application in condition for allowance because: Concerning the rejection concerning the charges made in point #5 of the Final Rejection, Applicants argue that the Examiner has provided no references stating that compounds must be electrically neutral and have not cited references proofing that the skilled chemist would not understand what counter ions are being claimed. This is not persuasive. Apart from the impossibility of proving a negative, it is the most elementary principle of basic chemistry that charges in a formula must be balanced. For example, Pauling (General Chemistry), third complete paragraph, page 195. See also Skoog (Fundamentals of Analytical Chemistry), point #5, page 91. Secondly, the case law cited previously by the Examiner also makes this requirement.

Applicants make two arguments concerning the enablement rejection over cancer made in point #6. Firstly, that the claim limitation of "killing tumor cells in vivo" is not the same as treating cancer. Secondly that the dose information provided in Morgan ('808) provides the dose information required by a physician to practice Applicants' invention. This is not persuasive. Applicants' distinction between killing tumor cells and treating cancer is a distinction without a difference. In vivo means in living beings. That clearly embraces treating cancer in those beings among other things. Secondly, Morgan ('808) provides a dose of 1 mg/kg for treating tumors in rats. The compounds used by Morgan ('808) are only superficially related to those of Applicants. Morgan uses chlorin compounds. Applicants have compound with four additional nitrogen atoms in the ring and four fused benzene rings, not found in Morgan ('808). The dosing data provided by the reference was determined from a specific rat experiment. Applicants provide no data fro the same assay that a physician could rely upon to determine the dose. Finally, the lack of dosing data is only a small part of one of the eight factors used to analyze enablement. .

MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1600